

REMARKS

Applicants respectfully request reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow.

Status of the claims

Claims 1, 2, 4-7, 13-15, 17-20, 24, 25, 43-56, 67-74 and 81-91 were pending and under active consideration in the subject application. With this Response, claims 1, 14, 19, 24, 43, and 81 have been amended; and claims 13, 44, 82, 83, 85, 86, and 88 have been canceled. No new claims have been added. Hence, upon entry of this paper, claims 1, 2, 4-7, 14-15, 17-20, 24, 25, 43, 45-56, 67-74, 81, 84, 87, and 89-91 will remain pending and under active consideration.

Claim amendments

Support for a siRNA molecule that is at least “95% identical” to SEQ ID NO 1 may be found at least at the first paragraph of page 8 of the as-filed application. Hence, Applicants submit that no new matter has been added with this Response.

Claim rejections under 35 U.S.C. § 102

Claims 1, 2, 4-7, 13-15, 17-20, 24, 25, 43-47, 50-56, 67-74 and 81-91 are rejected under 35 U.S.C. § 102(e) as being allegedly anticipated by US patent application publication no. 2006/0211642 to McSwiggen *et al.* (“McSwiggen”). Applicants respectfully traverse the rejection on the grounds that McSwiggen is not “prior art” at least with respect to the disclosure of SEQ ID NO 1618. Indeed, McSwiggen claims priority to dozens of applications, and the first disclosure of SEQ ID NO 1618 appears to have been made with PCT application no. US03/05043, which was filed on February 20, 2003.

The present application, however, benefits from a “priority” date of July 26, 2002 (*i.e.*, the filing date of US application no. 60/398,605). Hence, insofar as the disclosure of SEQ ID NO 1618 in McSwiggen took place *after* the earliest claimed priority date of the present invention, McSwiggen cannot anticipate the present invention under 35 U.S.C. § 102(e).

Withdrawal of the subject rejection is respectfully requested.

Claim rejections under 35 U.S.C. § 103

Claims 1, 2, 4-7, 13-15, 17-20, 24, 25, 43-56, 67-74 and 81-91 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Wands *et al.* (USPN 6,001,990, Cha *et al.* (USPN 6,297,370), Rice *et al.* (USPN 6,297,003), the combination in view of Fire *et al.* (USPN 6,506,559), the combination further in view of Fosnaugh *et al.* (U.S. 203/0143732), Morrissey *et al.* (U.S. 2003/0206887) and McKay *et al.* (USPN 6,133,246), and Alsobrook *et al.* (U.S. 2003/0219823). Applicants respectfully traverse this rejection on the following grounds.

As a threshold matter, Applicants respectfully submit that the proposed combination of references does not teach an siRNA molecule at least 95% identical to SEQ ID NO 1, which molecules are additionally capable of inactivating Hepatitis C virus. Hence, insofar as, a single prior art reference or a combination of references must teach or suggest each and every element of a claimed invention to establish a *prima facie* case of obviousness, the present rejection must fail.

In addition, the primary references teach the use of the oligonucleotides disclosed therein for “antisense” inhibition. While some investigators (*see e.g.*, Fire) have praised the advantages of siRNA technology, it nevertheless remains well-appreciated by the ordinary artisan today—let alone at the time the invention was made—that mere identification of an antisense transcript (or even an “inhibitory” antisense transcript), without more, provides little by way of predicting the behavior of the same transcript in siRNA-targeted gene inhibition. *See e.g.*, discussion in “Background of the Invention.” And, while obviousness does not require “absolute predictability,” Applicants respectfully submit that the present application fails to meet a minimum threshold of “at least some degree of predictability” required for a determination of obviousness. M.P.E.P. 2143.02(II).

Therefore, Applicants respectfully submit that the combination of cited references cannot render any of the pending claims obvious. Accordingly, Applicants respectfully request withdrawal of the Section 103 rejection.

Conclusion

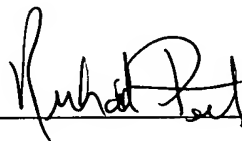
Applicants believe that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested. The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check or credit card payment form being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicants hereby petition for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

Date: June 5, 2009

By

A handwritten signature in black ink, appearing to read 'Richard C. Peet', is written over a horizontal line.

Richard C. Peet, Ph.D.
Registration No. 35,792

FOLEY & LARDNER LLP
Customer Number: 27476
Telephone: (202) 672-5483
Facsimile: (202) 672-5399